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EXAMINER				
MILLER, BRANDON J				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/772,658

Applicant(s)

CAI, YIGANG

Examiner

BRANDON J. MILLER

Art Unit

2617

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

I. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/4/2008 has been entered and claims 1-11 and 13-21 remain pending in the application.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

II. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 contains the limitation “determining whether said called party has previously screened calls from said calling party”. This limitation was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the

time the application was filed, had possession of the claimed invention. The limitation first appears in this amendment dated 8/4/2008. However, because the amendment adding this limitation is over four years after the 2/05/2004 filing date of the application and the limitation is not recited or suggested anywhere else in the application as filed, the amendment constitutes new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

III. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 recites the limitation “In a Short Message Service (SMS) center, apparatus for screening an SMS or MMS call, comprising: in an SMS center for serving a calling party of said call”. This language does not adequately describe the apparatus because it is unclear how an apparatus can comprise “in a (SMS) center for serving a calling party of said call”. The limitation renders the claim indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 recites the limitation “In a Short Message Service (SMS) center, apparatus for screening an SMS or MMS call” in lines 1-2. This language does not adequately describe the SMS center because it is unclear how an apparatus for screening MMS calls can be in the SMS center. The limitation renders the claim indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following art rejection is based on the best possible interpretation of the claim language in light of the rejections under 35 U.S.C. 112, first and second paragraphs.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

IV. Claims 1, 6-7, 9-10, 13, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCann (US 2003/0091170 A1) in view of Zhang et al. (US 7,116,972 B1).

Regarding claim 1 McCann teaches a method of screening a Short Message Service (SMS) or Multimedia Message Service (MMS) call (see paragraph [0012]). McCann teaches responsive to receipt of an SMS or MMS call in an originating SMS or MMS center for serving a calling party of said call, performing originating screening using data supplied by said calling party, for determining whether said calling party may attempt to complete a call to a called party of said called party (see paragraph [0012]). McCann teaches responsive to determining in the originating SMS or MMS center that said calling party may attempt to complete said call, performing terminating screening in a SMS or MMS center for serving said called party of said call, using data supplied by said called party, for determining whether said called party of said call can accept calls from said calling party (see paragraphs [0035] & [0036]). McCann does not specifically teach wherein the step of performing terminating screening comprises determining in said SMS or MMS center for serving said called party whether said called party allows calls

having characteristics of said call to be completed to said called party; and determining whether said called party has previously screened calls from said calling party. Zhang teaches wherein the step of performing terminating screening comprises determining in said SMS or MMS center for serving said called party whether said called party allows calls having characteristics of said call to be completed to said called party; and determining whether said called party has previously screened calls from said calling party (see col. 3, lines 15-32). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device in McCann adapt to include wherein the step of performing terminating screening comprises determining in said SMS or MMS center for serving said called party whether said called party allows calls having characteristics of said call to be completed to said called party; and determining whether said called party has previously screened calls from said calling party because the device in McCann is capable of retrieving or looking up information regarding the called party during a terminating screening process (see McCann, paragraph [0035]) and including the information taught in Zhang would improve McCann's prepaid SMS screening service.

Regarding claim 6 Zhang teaches testing whether the destination number of the called party is in a list of numbers to which the calling party may not complete calls (see col. 3, lines 15-32).

Regarding claim 7 McCann teaches testing whether the calling party may originate a service type of the call (see paragraph [0012], prepaid and postpaid service relates to service type).

Regarding claim 9 McCann and Zhang teach a device as recited in claim 7 and is rejected given the same reasoning as above.

Regarding claim 10 Zhang teaches testing whether a content classification of the call is one in which the called party is willing to accept (see col. 3, lines 15-32).

Regarding claim 13 McCann in a Short Message Service (SMS) center an apparatus for screening an SMS or MMS call (see paragraph [0012]). McCann teaches in an SMS center for serving a calling party of said call, responsive to receipt of an SMS call, for performing originating screening using data supplied by said calling party, for determining whether said calling party may attempt to complete a call to a called party of said call (see paragraph [0012]). McCann teaches in a SMS or MMS center for serving a called party of the call, means, responsive to determining that the calling party may attempt to complete said call, for performing terminating screening using data supplied by said called party, for determining whether said called party of said call can accept calls from said calling party (see paragraphs [0035] & [0036]). McCann does not specifically teach means for performing terminating screening comprises means for determining whether said called party has allowed calls having characteristics of said call to be completed to said called party; and wherein the means for performing terminating screening further comprises means for determining whether the called party has screened calls from said calling party. Zhang teaches means for performing terminating screening comprises means for determining whether said called party has allowed calls having characteristics of said call to be completed to said called party; and wherein the means for performing terminating screening further comprises means for determining whether the called party has screened calls from said calling party (see col. 3, lines 15-32). It would have

been obvious to one of ordinary skill in the art at the time the invention was made to make the device in McCann adapt to include means for performing terminating screening comprises means for determining whether said called party has allowed calls having characteristics of said call to be completed to said called party; and wherein the means for performing terminating screening further comprises means for determining whether the called party has screened calls from said calling party because the device in McCann is capable of retrieving or looking up information regarding the called party during a terminating screening process (see McCann, paragraph [0035]) and including the information taught in Zhang would improve McCann's prepaid SMS screening service.

Regarding claim 21 McCann teaches a method of screening a Short Message Service (SMS) call (see paragraph [0012]). McCann teaches responsive to receipt of an SMS call in an originating SMS center for serving a calling party of said call, performing originating screening in said originating SMS center using data supplied by said calling party, for determining whether said calling party may attempt to complete a call to a called party of said call (see paragraph [0012]). McCann teaches responsive to determining in the originating SMS center that said calling party may attempt to complete said call, performing terminating screening in a SMS center for serving said called party of said call, using data supplied by said called party, for determining whether said called party of said call can accept calls from said calling party (see paragraphs [0035] & [0036]). McCann does not specifically teach wherein the step of performing terminating screening comprises the step of determining in said SMS center for serving said called party of said call whether said called party has allowed calls having characteristics of said call to be completed to said called party and determining whether said

called party has screened calls from said calling party. Zhang teaches wherein the step of performing terminating screening comprises the step of determining in said SMS center for serving said called party of said call whether said called party has allowed calls having characteristics of said call to be completed to said called party and determining whether said called party has screened calls from said calling party (see col. 3, lines 15-32). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device in McCann adapt to include wherein the step of performing terminating screening comprises the step of determining in said SMS center for serving said called party of said call whether said called party has allowed calls having characteristics of said call to be completed to said called party and determining whether said called party has screened calls from said calling party because the device in McCann is capable of retrieving or looking up information regarding the called party during a terminating screening process (see McCann, paragraph [0035]) and including the information taught in Zhang would improve McCann's prepaid SMS screening service.

V. Claims 2-3 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCann (US 2003/0091170 A1) in view of Zhang et al. (US 7,116,972 B1) and Cast et al. (US 6,975,876 B1).

Regarding claim 2 McCann and Zhang teach a device as recited in claim 1 except for determining the number of destinations which the calling party is attempting to reach; and rejecting the call if the number exceeds a limit defined by a class of service of the calling party. Cast teaches determining the number of destinations which the calling party is attempting to

reach; and rejecting the call if the number exceeds a limit defined by a class of service of the calling party (see abstract, col. 40, lines 52-61 and col. 42, lines 3-6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include determining the number of destinations which the calling party is attempting to reach; and rejecting the call if the number exceeds a limit defined by a class of service of the calling party because this would allow for an improved method of screening SMS messages in accordance with user preferences.

Regarding claim 3 McCann, Zhang, and Cast teach a device as recited in claim 2 and is rejected given the same reasoning as above.

Regarding claim 14 McCann, Zhang, and Cast teach a device as recited in claim 2 and is rejected given the same reasoning as above.

Regarding claim 15 McCann, Zhang, and Cast teach a device as recited in claim 2 and is rejected given the same reasoning as above.

VI. Claims 4-5 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCann (US 2003/0091170 A1) in view of Zhang et al. (US 7,116,972 B1) and Molnar et al. (US 2002/0168978 A1).

Regarding claim 4 McCann and Zhang teach a device as recited in claim 1 except for testing for geographic allowability of a call to the called party in accordance with a class of service of the calling party. Molnar teaches testing for geographic allowability of a call to the called party in accordance with a class of service of the calling party (see paragraphs [0034] & [0035]). It would have been obvious to one of ordinary skill in the art at the time the invention

was made to make the device adapt to include testing for geographic allowability of a call to the called party in accordance with a class of service of the calling party because this would allow for an improved method of screening SMS messages in accordance with user preferences.

Regarding claim 5 McCann and Zhang teach a device as recited in claim 1 except for testing whether the calling party may complete SMS or MMS calls to a roamer; and if the calling party may not complete SMS or MMS calls to a roamer, determining whether the called party is a roamer and blocking the call if the called party is a roamer. Zhang does teach testing whether the calling party may complete SMS or MMS call away from the network; and if the calling party may not complete SMS or MMS calls away from the network blocking the call (see paragraph [0038]). Molnar teaches testing whether the calling party may complete SMS or MMS calls to a roamer (see paragraph [0032]). Molnar teaches and if the calling party may not complete SMS or MMS calls to a roamer, determining whether the called party is a roamer and blocking the call if the called party is a roamer (see paragraphs [0032], [0034] & [0035]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include testing whether the calling party may complete SMS or MMS calls to a roamer; and if the calling party may not complete SMS or MMS calls to a roamer, determining whether the called party is a roamer and blocking the call if the called party is a roamer because this would allow for an improved method of screening SMS messages in accordance with user preferences.

Regarding claim 16 McCann, Zhang, and Molnar teach a device as recited in claim 4 and is rejected given the same reasoning as above.

Regarding claim 17 McCann, Zhang, and Molnar teach a device as recited in claim 5 and is rejected given the same reasoning as above.

VII. Claims 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCann (US 2003/0091170 A1) in view of Zhang et al. (US 7,116,972 B1) and Allison et al. (US 6,819,932 B2).

Regarding claim 8 McCann and Zhang teach a device as recited in claim 1 except for testing whether the keyword, subject, title, or URL of a web page of the SMS or MMS call is on a list of call types which the called party does not wish to receive. Allison teaches testing whether the keyword, subject, title, or URL of a web page of the SMS or MMS call is on a list of call types which the called party does not wish to receive (see abstract, col. 8, lines 45-67 and col. 9, lines 1-10). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include testing whether the keyword, subject, title, or URL of a web page of the SMS or MMS call is on a list of call types which the called party does not wish to receive because this would allow for an improved method of screening SMS messages in accordance with user preferences.

Regarding claim 18 McCann, Zhang, and Allison teach a device as recited in claim 8 and is rejected given the same reasoning as above.

VIII. Claims 11 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCann (US 2003/0091170 A1) in view of Zhang et al. (US 7,116,972 B1) and Kim et al. (US 2005/0020289 A1).

Regarding claim 11 McCann and Zhang teach a device as recited in claim 1 except for determining whether the call identifies a merchant from which the called party does not wish to receive SMS or MMS calls. Kim teaches allowing a user to register an unsolicited phone number or word that would be used to determine which messages would be deleted (see paragraph [0025]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include determining whether the call identifies a merchant from which the called party does not wish to receive SMS or MMS calls because this would allow for an improved method of screening SMS messages in accordance with user preferences.

Regarding claim 19 McCann, Zhang, and Kim teach a device as recited in claim 11 and is rejected given the same reasoning as above.

Regarding claim 20 McCann and Zhang teach a device as recited in claim 13 except for testing whether a language of the call is one in which the called party is willing to receive. Kim teaches allowing a user to register words that would be used to determine which messages would be blocked or accepted (see paragraphs [0019] & [0025]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include testing whether a language of the call is one in which the called party is willing to accept because this would allow for an improved method of screening SMS messages in accordance with user preferences.

Response to Arguments

IX. Applicant's arguments filed 8/4/2008 have been fully considered but they are not persuasive.

Regarding claims 1, 13, and 21 the combination of McCann and Zhang teaches a device as claimed. Applicant argues that the identity of the unit performing the terminating screening function of the present invention is different from the identity of the unit performing the terminating screening function in McCann and Zhang. Applicant has also argues that Zhang discloses a system in which the terminating screening is performed in the customer terminal of the terminating party. However, applicant has not specifically referred to the cited portions of McCann and Zhang, or any other portions of McCann and Zhang, to substantiate the above arguments. As such the arguments amount to general allegations and the above prior rejection will remain.

Conclusion

X. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANDON J. MILLER whose telephone number is (571)272-7869. The examiner can normally be reached on Mon.-Fri. 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George Eng/
Supervisory Patent Examiner, Art Unit 2617

September 19, 2008

/Brandon J Miller/
Examiner, Art Unit 2617